

Applicant : Dennis G. PRIDDY
Appl. No. : 09/420,459
Examiner : Luong T. Nguyen
Docket No. : 11104.2

REMARKS

In an effort to more clearly describe the present invention, Applicant has made a number of amendments to the claims. Claim 1 has been amended to remove the limitation concerning identifying a non-biometric automatic identification indicia from information coded within the digitized image to a newly added dependent claim 23, and new claims 24 to 29, also directed to non-biometric automatic identification indicia being identified by the real time automatic identification circuit (claims 24 and 27-29) or being included in the transmission received at the communications node (claims 25-26), have been added to claim the invention more completely.

Claim Rejections

(i) Rejections Based On Glass

(a) § 102 Rejections Based On Glass

Claim 9

Claims 9-12 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,332,193 to Glass ("Glass"). We respectfully traverse.

Glass discloses a communications node that receives a message sent by a host desktop computer incorporating a cropped and compressed digital image that is combined with a secret key, (optionally) a digital token, and a digital signature. The communications node (i.e., the authentication server) validates that the message has not been altered during transmission by computing the same or complementary digital signature algorithm on the transmitted digital image data, using its knowledge of the token or complementary token respectively, along with the server's copy of the secret key.

By contrast, Applicant's claim 9, as amended, and claims 10-13 depending therefrom, recite, among other things, a communications node comprising "means for receiving a

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transmission incorporating data element identifiers and containing an automatic identification indicia determined from a digital representation of a biometric attribute of [a] remote user and distinct from said digital representation.” As explained in Applicant’s specification, such an automatic identification indicia is obtained by processing the captured digital image, see Specification at 10, and thus is not a captured digital image or a cropped or compressed portion thereof. *See, e.g.,* Glass at Fig. 2 (digital representation of image transmitted through security firewall). Because this feature, among others, is neither disclosed nor suggested in Glass, Glass does not anticipate and withdrawal of the § 102 rejection of claims 9-12 respectfully is requested.

Claim 11

Further, regarding claim 11, Glass does not teach or suggest a communications node having a “means for verifying the identity and authenticity of the remote user associated with said received automatic identification indicia” as required by Claim 11. Rather, Glass teaches away from using a “received automatic identification indicia” (emphasis supplied) in teaching to receive the digital image (complete cropped and/or compressed) and at the communications node generate a biometric template that then can be compared to a database for authentication. *See, e.g.,* Glass at Col. 3, line 55-59. Accordingly, the Examiner’s rejection of claim 11 under § 102 should be withdrawn for this additional reason.

(b) § 103 Rejection Based On Glass

Claim 13

Claim 13 was rejected under 35 U.S.C. § 103 as being obvious in view of the combination of Glass and Alperovich. This ground of rejection should be withdrawn because Alperovich does not cure the deficiency of Glass with respect to the independent claim 9, and thus claim 13 which depends from claim 9 is allowable for at least the same reasons that claim 9

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is allowable. Specifically, the § 103 rejection should be withdrawn because the combination of Glass and Alperovich does not disclose or suggest, among other things, a communications node capable of receiving the transmission “containing an automatic identification indicia determined from a digital representation of a biometric attribute of [a] remote user distinct from said digital representation.”

The Examiner’s § 103 rejection based on Glass also should be withdrawn because the Examiner has not made the required specific showing that one of ordinary skill in the art would have been motivated to make the combination of Glass and Alperovich as suggested by the Examiner. Absent this showing, the § 103 rejection is improper. *See In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998) (“even where the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill would have been motivated to select the references and to combine them to render the claimed invention obvious.”). We respectfully submit that the Examiner’s position that “applying the teaching of Alperovich to the device of Glass allows a user to view a scene at a remote location (Action, page 3) fails to identify the predicate motivation to apply the teaching of Alperovich to Glass in the first instance. We further respectfully submit that this is because there is no motivation to make the combination. Alperovich is directed to reducing the transmission load created by digital images (Alperovich, Col. 3, lines 23-29) whereas Glass is directed to secure transmission of biometric data to a remote location (Glass, Col. 3 at lines 30-42). Absent a motivation, and the Examiner has provided none, there is no basis to apply Alperovich to Glass - except impermissible hindsight, and thus the rejection of claim 13 should be withdrawn.

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(iii) Rejections Based On Marwell:

Claims 1, 2, and 14-16

Claims 1, 2, and 14-16 were rejected under 35 U.S.C. § 103 as being obvious in view of the combination of U.S. Patent No. 6,377,699 to Musgrave (“Musgrave”) and U.S. Patent No. 6,668,055 to Marwell (“Marwell”).

Musgrave, the primary reference relied upon by the Examiner, discloses a handheld imaging apparatus incorporating a particular lens structure, magnifying mirror, and illumination means operably appended to a conventional digital camera. Musgrave functions to capture a high-quality image of an iris and employs such image in conjunction with a telephone service provider to verify the identity of the user and subsequently unlock the user’s telephone.

Marwell, the secondary reference presumably relied upon by the Examiner to cure the acknowledged deficiencies of the primary reference, describes a system and method for creating a personalized directory assistance system that enables a cellular telephone user to speak directly to a customer service representative who, in turn, is allowed visual access to the caller’s personal contact list. The personal contact list accessed by the customer service representative is stored on a database that is maintained synchronized with, but remote from, a contact list stored in the caller’s cellular telephone.

Preliminarily, we respectfully submit that the Examiner is incorrect in concluding that Marwell teaches a feature that Musgrave fails to disclose, namely “a personal database secure to all but a specified user” (Action at 4). Specifically, Marwell teaches that the personal contact list is resident on the user/caller’s phone, but importantly, that same database also is resident on a database 16 remote from the caller’s phone and is accessible by any customer service representative -- i.e., not “all but the specified” caller. Moreover, any customer service

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representative has access to that database 16 even if the caller calls from a phone not containing the caller's personal contact list. *See, e.g.,* Marwell at Col. 9, Ins. 64-Col. 10, ln. 35.

Further, Marwell does not teach or suggest that the personal contact list resident in the caller's phone is "secure to all but the specified user" as required by claims 1, 14 and 15, but instead is silent. Rather, Marwell teaches using biometric identification to permission making a telephone call, but does not teach or suggest to use biometric identification to permission access the personal contact list. That the Examiner has inferred so can only be based upon a hindsight reconstruction, which respectfully is an improper basis for a rejection under § 103.

Second, neither Musgrave nor Marwell, taken alone or in combination, discloses or suggests, among other things, the creation or utility of a "multi-function integrated semiconductor device comprising a single integrated circuit containing" an image sensor, a real time image processing circuit, and an "automatic identification circuit within the real time image processing circuit responsive to a captured image to generate an automatic identification indicia from a digitized image of a biometric attribute" as called for in claim 1, as presently amended, and as similarly required by claims 14 and 15. Musgrave and Marwell each disclose structures that use multiple discrete integrated circuits connected together. These do not teach or suggest the single integrated circuit module of applicant's invention having the structure as defined by claims 1, 14 and 15, or the benefits in terms of productivity and capability enhancements of such an architecture that applicant was first to realize and claim. *See, e.g.,* Specification at 4-5.

Third, we respectfully traverse the Examiner's attempt to combine Musgrave and Marwell. Musgrave teaches a system operable only between a cellular telephone and that telephone's particular service provider. Marwell teaches a system wherein an unknown service representative is allowed complete visual access to the entirety of a copy of the user's personal

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database. It is, therefore, unclear how one skilled in the art could possibly combine the restrictions of Musgrave and Marwell to result in the disclosures of the instant invention wherein system operability is extended to all cellular service providers, and the Internet, and wherein the user's secured personal database resides only within the multi-function semiconductor device comprising a single integrated circuit (claims 1, 14 and 15), and further is accessible only by the one authorized user upon biometric authentication (claim 15). The Examiner certainly has not made any specific showing that one of ordinary skill in the art would have been motivated to make the combination of Musgrave and Marwell suggested by the Examiner, let alone how one skilled in the art would combine those references, except by an impermissible hindsight reconstruction.

For all of the foregoing reasons, withdrawal of the § 103 rejection of claims 1, 14 and 15, and claims 2-8 and 16, which depend therefrom, respectfully is requested.

Claims 3, 4, and 14

Claims 3, 4, and 14 were further rejected under 35 U.S.C. § 103 as being obvious in view of the combination of Marwell, Musgrave, and a tertiary reference, U.S. Patent No. 6,317,609 to Alperovich ("Alperovich").

Preliminarily, even the combination of Marwell, Musgrave, and Alperovich does not disclose or suggest, among other things, the creation or utility of the multi-function integrated semiconductor device recited in independent claim 1, from which rejected claims 3 and 4 depend, or claim 14, for the reasons discussed above.

Furthermore, Alperovich is directed to telecommunications systems and methods for transmitting digital images produced by a digital camera attached to or integrated with a mobile station from the mobile station to a receiving terminal through the Internet. Alperovich neither

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discloses nor suggests, among other things, the functionality and architecture of the claimed instant multi-function integrated semiconductor device incorporating a memory and an image processing circuit in a single integrated circuit that operates on a captured image in real-time. Nor does Alperovich teach the functions and methods resident at the communications node, as previously mentioned. Alperovich is indeed directed to solving a different problem than that first solved by Applicant's claimed subject matter.

Moreover the Examiner has made no specific showing that one of ordinary skill in the art would have been motivated to combine Alperovich with the prior disclosures of the primary or secondary references. Specifically, the Examiner has not identified "where there is some teaching, suggestion, or motivation to [combine or modify the teachings of the prior art] found in the references themselves, or in the knowledge generally available" -- the standard advanced by the Examiner, (Office Action, p. 5). Having failed to identify the predicate showing of motivation, the obviousness rejections should be withdrawn.

For the foregoing reasons, withdrawal of the § 103 rejection of claims 3, 4, and 14 for these additional reasons respectfully is requested.

Claims 5-8

Claims 5-8 were rejected under 35 U.S.C. § 103 as being obvious in view of the combination of Marwell, Alperovich, and U.S. Patent No. 6,512,919 to Ogasawara ("Ogasawara").

This ground of rejection should be withdrawn because even the combination of Marwell, Alperovich, and Ogasawara does not disclose or suggest a multi-function integrated semiconductor device incorporated within a portable wireless communications product and such

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device including an Internet browser and means for real-time scanning, decoding, and transmitting information encoded in an automatic identification indicia.

Further, the combination of Marwell, Alperovich, and Ogasawara does not disclose or suggest means for transmitting images including data element identifiers, as required by claim 5 and claims 6-8 depending therefrom. Incorporating data element identifiers within a transmitted message enables the widest possible message compatibility with the widest variety of remote receiving communications nodes. It also advantageously precludes the need to repeatedly upload applications software from a remote communications node to a portable wireless communication product in order to effect a purchase transaction and, additionally, precludes the need to maintain various versions of application software in order to maintain compatibility with a given model of a portable wireless communications product and/or wireless service provider. Because these features, among others, are recited in rejected claims 5-8, withdrawal of the § 103 rejection of those claims for these additional reasons is respectfully is requested.

CONCLUSION

Applicant believes that all of the claims pending in the application now are in condition for allowance. Reconsideration of this application in view of the foregoing amendments and remarks respectfully is requested.

The Examiner is invited to call Applicant's undersigned attorney if doing so would expedite prosecution.

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The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 15-0665.

Respectfully submitted,

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